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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,311	03/13/2001	Pramod B. Mahajan	0961D	2426

7590 06/03/2003

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EXAMINER

HELMER, GEORGIA L

ART UNIT	PAPER NUMBER
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1638

8

DATE MAILED: 06/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/805,311

Applicant(s)

MAHAJAN, PRAMOD B.

Examiner

Georgia L. Helmer

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2--87 is/are pending in the application.
- 4a) Of the above claim(s) 7-74 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 81 is/are allowed.
- 6) ☒ Claim(s) 2-6,75-80 and 82-87 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of the Claims

1. The Office acknowledges receipt of Applicants Response; dated 17 March 2003, paper number 7. The Examiner further acknowledges the use of the "Revised Amendment Format" with appreciation.
2. Applicant has cancelled claim 1, and amended claims 2-4. New claims 75-87 have been added. Claims 2-87 are pending. Claims 2-6 and 75-87 are examined in the instant action. This application contains claims 7-74 drawn to an invention nonelected with traverse in Paper No. 5. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.
3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

4. All rejections not addressed below have been withdrawn.
5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

6. Claim 2 remains rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,232,527. Although the conflicting claims are not identical, they are not patentably distinct from each other. The recombinant expression cassette of claim 2, comprising DNA encoding the polypeptide of SEQ ID NO: 2, is obvious over the claims of 6,235,972, which are drawn to the same DNA. It would have been obvious to use the DNA in an expression cassette to transform host cells and plants.

Applicant traverses, stating primarily that claim 2 is directed to a recombinant expression cassette which expresses the polypeptide of claim 77 (former claim 1(c)). Therefore the claim is defined by the polypeptide which was restricted out of US 09/426,557 as a separate invention.

Applicant's traversal has been considered and is unpersuasive because claim 2 is drawn to the same DNA, of the same host cell and plant as 09/426,557.

Accordingly this rejection is maintained.

Claim Rejections - 35 USC § 112-first,

Written Description

7. Claims 77-80 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant traverses, stating primarily that evidence submitted in Appendices A and B confirms the identity of the claimed Rad2/FEN-1 sequences.

Applicant's traversal has been considered and is unpersuasive because while Applicant's evidence submitted in Appendices A and B includes alignment with other sequences, how this evidence relates to the claimed percentages sequence identity of the SEQ ID NO: 2 is not clear.

Claim Rejections - 35 USC § 101

8. Claims 3, 75, 82 and 83 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. These claims read on a maize cell that would naturally comprise said polypeptide.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 3-6, 75, 76 and 82-87 are rejected under 35 U.S.C. 102(b) as being anticipated by Baszczynski, et. al., US 5,824,870, issued 20 October 1998.

Baszczynski teaches a nonhuman host cell , a transgenic maize plant (claim 8), and a monocot, comprising a polypeptide having 80, 85, 90, and 95 % identity with SEQ ID NO: 2. Baszczynski also teaches a host cell, a transgenic maize plant and seed (Table 1, column 10)) comprising SEQ ID NO: 2.

Accordingly, Baszczynski anticipates the claimed invention.

Claim Rejections - 35 USC § 112

11. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-6, 76, 84, and 84-87 are rejected under 35 USC § 112.2. These claims are indefinite in that it is unclear of their relationship between the description of the “transgenic” and the fact that the plant comprises the polypeptide. Is it transgenic because it is transformed with a gene that encodes the polypeptide, or it is transformed with another gene?

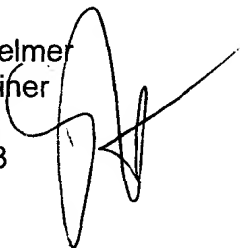
REMARKS

12. Claim 81 is allowable.
13. SEQ ID NO: 2 is free of the prior art of record.
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Georgia L. Helmer whose telephone number is 703-308-7023. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Georgia L. Helmer
Patent Examiner
Art Unit 1638
May 27, 2003




ELIZABETH F. McELWAIN
PRIMARY EXAMINER
GROUP 1800